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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/358,321 07/21/99 SUKHAPINDA

K 50.447

025212
DOW AGROSCIENCES LLC
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INDIANAPOLIS IN 46268

HM12/1030

EXAMINER

COLLINS, C

ART UNIT	PAPER NUMBER
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1638

DATE MAILED:

10/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/358,321

Applicant(s)

SUKHAPINDA ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/21/99.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants are reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-13, drawn to a nucleic acid construct comprising a nucleic acid sequence that encodes an antibody or fragment thereof having the ability to bind to a maize stearyl-ACP Δ -9 desaturase transit peptide that directs a passenger protein to an organelle, a plant cell, a plant, and a method of decreasing the steady state level of a passenger protein in a plant cell, classified in class 435, subclass 419, for example.
 - II. Claims 1-13, drawn to a nucleic acid construct comprising a nucleic acid sequence that encodes an antibody or fragment thereof having the ability to bind to a maize palmitoyl-ACP thioesterase transit peptide that directs a passenger protein to an organelle, a plant cell, a plant, a method of decreasing the steady

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state level of a passenger protein in a plant cell, classified in class 800, subclass 298, for example.

- III. Claims 14-16, drawn to a monoclonal antibody that specifically binds to a maize stearoyl-ACP Δ -9 desaturase epitope, classified in class 530, subclass 388.1, for example.
- IV. Claim 17, drawn to a hybridoma cell line designated 10E10, classified in class 435, subclass 326, for example.
- V. Claims 18-19, drawn to a monoclonal antibody that specifically binds to a maize palmitoyl-ACP thioesterase epitope, classified in class 530, subclass 388.1, for example.
- VI-XII. Claim 20, drawn to a nucleic acid construct comprising SEQ ID NOS: 21, 22, 24, 25, 31, 43, and 48 respectively, classified in class 435, subclass 320.1.
- XIII-LIII. Claim 21, drawn to an isolated nucleic acid fragment comprising SEQ ID NOS: 1, 2, 3, 5, 7, 8, 9, 10, 11, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50 and 51, respectively, classified in class 536, subclass 24.3.
- LIV-LX. Claim 22, drawn to a polypeptide comprising the amino acid sequence of SEQ ID NOS: 4, 6, 12, 13, 14, 15 and 32 respectively, classified in class 530, subclass 300, for example.
- LXI-LXVII. Claim 23, drawn to an isolated nucleic acid encoding a protein having the amino acid sequence of SEQ ID NOS: 4, 6, 12, 13, 14, 15 and 32 respectively, classified in class 536, subclass 23.1, for example.

3. The inventions are distinct, each from the other because of the following reasons:
4. The inventions of Groups I-LXVII are distinct products.
5. The nucleic acid constructs of Groups I-II and VI-XII are distinct in that each comprises a different nucleic acid sequence encoding a different antibody or fragment thereof, and thus can be used in different methods, such as a method of producing a particular recombinant antibody or fragment thereof in cell culture, or a method of decreasing the steady state level of a passenger protein in a plant cell.
6. The monoclonal antibodies of Groups III and V are distinct in that they recognize different epitopes on different proteins, and thus can be used in different methods, such as a method of detecting the presence of a maize stearyl-ACP Δ -9 desaturase transit peptide by ELISA or by immunolocalization, or a method of detecting the presence of a maize palmitoyl-ACP thioesterase transit peptide by ELISA or by immunolocalization.
7. The hybridoma cell of Group IV is biologically distinct from the nucleic acid constructs of Groups I-II and VI-XII, the monoclonal antibodies of Groups III and V, the nucleic acid fragments of Groups XIII-LIII, the polypeptides of Groups LIV-LX, and the isolated nucleic acids of Groups LXI-LXVII, and thus can be used in different methods, such as a method of producing a particular monoclonal antibody.
8. The nucleic acid fragments of Groups XIII-LIII are distinct in that each comprises a different nucleic acid sequence, and thus can be used in different methods, such as a method for detecting a specific nucleotide sequence by Northern or Southern hybridization, or a method for the amplification of a particular nucleic acid fragment by PCR.

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9. The polypeptides of Groups LIV-LX are distinct in that each comprises a different amino acid sequence, and thus can be used in different methods, such as a method of producing particular polyclonal antibodies by immunizing a rabbit, or a method of measuring the amount of a particular polypeptide in a sample by competitive inhibition ELISA.

10. The isolated nucleic acids of Groups LXI-LXVII are distinct in that each comprises a different nucleic acid sequence, and thus can be used in different methods, such as a method of producing a particular recombinant protein in cell culture, or a method of detecting a particular nucleic acid sequence in a cDNA library by hybridization screening.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and 1 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
October 26, 2001

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800

